

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-26 are pending in this application. Claim 14 has been amended to clarify that a combination of a container and the toner contained by the container are the subject matter claimed, not just the container itself. Original Claim 14 and the description of the process cartridge starting in the paragraph bridging pages 76-77 of the specification, for example, provide support for the subject matter of amended Claim 14 so that it is clear that amended Claim 14 includes no new matter.

The outstanding Office Action includes a rejection of Claim 14 under the second paragraph of 35 U.S.C. §112, a rejection of Claims 1-13, 15-18, 21, 23, and 25 under 35 U.S.C. §103(a) as being unpatentable over Emoto et al. (U.S. Pat. Pub. No. 2003/0134220 A1, Emoto) in view of Nakanishi et al. (EP 1 026 554 A, Nakanishi), a rejection of Claims 19, 20, 22, 24, and 26 under 35 U.S.C. §103(a) as being unpatentable over Tomita et al. (U.S. Patent No. 6,740,460, Tomita) in view of So (JP 2000-305360), and a provisional rejection of Claims 1-13, 15-18, 21, 23, and 25 as being unpatentable over Claims 1-29 of copending Application Serial No. 10/729,960 under the judicially created doctrine of obviousness-type double patenting.

Turning first to the rejection of Claim 14 under the second paragraph of 35 U.S.C. §112, it is believed that this rejection should be withdrawn in view of the present amendment to Claim 14 that makes it clear that a combination of a toner and container for that toner is the subject matter being claimed. If the Examiner disagrees for any reason he is invited to contact Applicants' representative at the below noted telephone number so that mutually agreeable changes in claim language can be determined.

With regard to the rejection of Claims 1-13, 15-18, 21, 23, and 25 under 35 U.S.C. §103(a) as being unpatentable over Emoto in view of Nakanishi, it is noted that the USPTO reliance upon Emoto as a “prior art” reference in a rejection based upon 35 U.S.C. §102(e)/103(a) is misplaced. In this regard note the statement of common ownership of Emoto and the present application set forth on the attached sheet signed by an attorney of record in accordance with MPEP §706.02 (I)(2)(II). Accordingly, reliance upon Emoto as a “prior art” reference is not proper in view of 35 U.S.C. §103(c). As Nakanishi alone clearly cannot serve to establish a valid *prima facie* case of obviousness, withdrawal of the outstanding rejection of Claims 1-13, 15-18, 21, 23, and 25 under 35 U.S.C. §103(a) based upon Emoto in view of Nakanishi is respectfully submitted to be in order.

In similar manner, the rejection of Claims 19, 20, 22, 24, and 26 under 35 U.S.C. §103(a) as being unpatentable over Tomita in view of So should be withdrawn because the USPTO reliance upon Tomita as a “prior art” reference in a rejection based upon 35 U.S.C. §102(e)/103(a) is misplaced. In this regard note the further statement of common ownership of Tomita and the present application set forth on the attached sheet signed by an attorney of record in accordance with MPEP §706.02 (I)(2)(II). Accordingly, reliance upon Tomita as a “prior art” reference is also not proper in view of 35 U.S.C. §103(c). As So alone clearly cannot serve to establish a valid *prima facie* case of obviousness, withdrawal of the outstanding rejection of Claims 19, 20, 22, 24, and 26 under 35 U.S.C. §103(a) as being unpatentable over Tomita in view of So under 35 U.S.C. §103(a) is respectfully submitted to be in order.

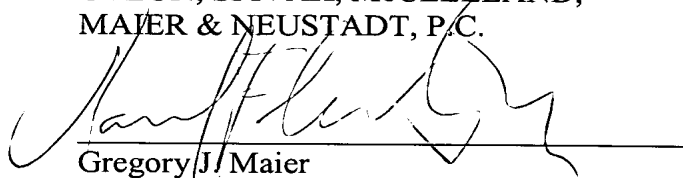
The provisional rejection of Claims 1-13, 15-18, 21, 23, and 25 as being unpatentable over Claims 1-29 of copending Application Serial No. 10/729,960 filed on December 9, 2003, under the judicially created doctrine of obviousness-type double patenting should be

withdrawn under MPEP §804(I)(B) as this is believed to be the only remaining rejection in this application.

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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